

REMARKS

In response to the Office Action mailed June 18, 2008, Applicants hereby request reconsideration of the rejections based upon the claim amendments and arguments submitted herewith. Claims 23-44 were last presented for examination, of which all were rejected, with the following issues being raised:

1. Claims 23, 25-31, 33-42, and 44 were rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 914,546 to Amos;
2. Claim 24 was rejected under 35 U.S.C. § 103(a) as obvious over Amos in view of U.S. Patent No. 6,363,698 to Swain; and
3. Claims 32 and 43 were rejected under 35 U.S.C. § 103(a) as obvious over Amos in view of U.S. Patent No. 2,130,442, and further in view of Swain.

Amendments

By the above amendments, Applicants have amended claims 23 and 24, and have added new claims 45 and 46, both of which ultimately depend from claim 23. New claim 45 is directed toward a saddle tree, where the flexible resin material is a polyurethane resin, and new claim 46 is a saddle comprised of such a saddle tree. Support for the new claims is found on page 8 of the specification, in the paragraph beginning on line 8.

Obviousness Rejections

Claim 23 was rejected as obvious over Amos on the basis of mere substitution of one known element for another. When simple substitution is the basis for a finding of obviousness, the MPEP states that the following must be articulated to establish a *prima facie* case of obviousness:

- (1) a finding that the prior art contained a device ... which differed from the claimed device by the substitution of some components (step, element, etc.) with other components;
- (2) *a finding that the substituted components and their functions were known in the art;*
- (3) a finding that one of ordinary skill in the art could have substituted one known element for another, and the results of the substitution would have been predictable; and
- (4) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

MPEP § 2143(B) (emphasis added). In the present case, there has been no finding that the substituted components *and their functions* were known in the art. As such, a *prima facie* case of obviousness cannot be established, and the rejection should be withdrawn. Further, where a *prima facie* case of obviousness is not made, Applicants are under no burden to come forward with additional evidence to support a finding of non-obviousness. MPEP 2142.

In claim 23, the saddle tree body includes a "Y-shaped strengthening bar wherein the forks of the Y-shape are directed towards the cantle end of the saddle tree". Amos teaches a *cushioning member* in the form of an X-shaped bar incorporated into the saddle tree, formed by a first set of strips 14 of resilient metal extending from points adjacent the rim of the cantle 3 to a point adjacent the pommel 4, at which point the two strips 14 merge, then diverge again into a second set of strips 15. (Amos, p. 2, ll. 47-58.) The strips 14, 15 forming the cushioning member are secured to the saddle tree at their respective ends, with their intermediate portions being bowed away from the tree in order to provide "the desired spring action." (Amos, p. 2, ll. 58-68.) The Office Action suggests that a Y-shaped *strengthening bar* may be substituted for this X-shaped

cushioning member because to do so would be a simple substitution of one functionally equivalent part for another. Assuming, *arguendo*, that both Y-shaped bars and X-shaped bars are generally known in the prior art—irrespective of use or function—the Office Action lacks a finding that a *cushioning bar* serves the same function as a *strengthening bar*. In fact, the Office Action includes no finding whatsoever as to what functions Y-shaped bars are known to serve in the prior art. Without such a finding relating to Y-shaped bars, a *prima facie* case of obviousness is not established over amended claim 23.

Each of claims 35-46 ultimately depend from claim 23, and each were rejected as obvious over Amos, or in the case of claims 32 and 43, a combination of prior art including Amos as the key teaching. Where a *prima facie* case of obviousness is not established over amended claim 23, neither is one established over any of these dependent claims.

Claim 24 was rejected as obvious, over Amos in view of Swain, on the basis that it was within the skill of one skilled in the art to select a known material on the basis of its suitability for the intended use. The Office Action correctly asserts that Amos does not teach forming the strengthening bar from carbon fiber, and thus relies on Swain to establish that carbon fiber is an appropriate choice of material for a strengthening bar. Swain teaches a saddle tree 1 having connectors 8 joining a pommel portion 2 with a cantle portion 3. (Swain, Col. 2, ll. 23-35; Fig. 2.) As disclosed by Swain, the connectors 8 have a “lazy S-shape” and may be formed from polypropylene or any other flexible material. (Swain, Col. 2, ll. 37-42; Fig. 2.) Additionally, a pair of steel tie bars 9 connect the pommel portion 2 to the cantle portion 3 to “maintain integrity, resilience and stiffness of the saddle tree 1.” (Swain, Col. 2, ll. 43-50; Fig. 2.) Swain thus teaches that steel is an appropriate material to strengthen the form of the saddle tree, and that carbon fiber is an appropriate material to provide additional flexibility to the saddle tree. Following this teaching, carbon fiber, a more flexible material, would not be considered

a suitable substitute for steel, a stiffer material, to one of ordinary skill in the art. As such, a *prima facie* case of obviousness is not established over amended claim 24.

Conclusion

For the foregoing reasons, Applicants request reconsideration of the rejections.

Respectfully submitted,

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